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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,742	06/05/2000	Andrew S. Van Luchene	99-091	8655
22927	7590	04/18/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,742

Applicant(s)

VAN LUCHENE ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/21/05 & 1/5/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 95-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 95-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/2005 has been entered.

Response to Amendment

2. Amendment and supplemental amendment received on 1/5/2005 and 1/21/2005 respectively are acknowledged and entered. The applicant has cancelled claims 1-94 and added new claims 95-108. Currently claims 195-108 are pending for examination.

Response to Arguments

3.1. Applicant's arguments, see page 4 of the amendment received on 1/5/2005 and page 7 of the supplemental amendment received on 1/21/05, with respect to rejection of claim 93 under USC 35 101, rejection of claims 1-59, 90-93 under 35 USC 112, first paragraph and rejection of claim 28 under 35 USC 112, second paragraph have been fully considered and are persuasive, as they have been canceled. Accordingly, the rejection of claim 93 under USC 35 101, rejection of claims 1-59, 90-93 under 35 USC 112, first paragraph and rejection of claim 28 under 35 USC 112, second paragraph have been withdrawn.

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3.2. Applicant's arguments filed on 1/5/2005 (see pages 4-5 in Remarks section) and on 1/21/05 (see page 7 in Remarks column) with reference to sections 102 and 103 rejections concerning the reference Ojha et al., hereinafter referred to Ojha, have been fully considered but they are not persuasive. The applicant argues that the reference Ojha fails to teach or suggest, *"determining whether at least one item desired for purchase by a buyer and at least one item being offered for sale by a seller correspond and determining an amount to be added to the price the buyer is willing to pay to match the price for which the item is being offered for sale "*. The examiner respectfully disagrees. Ojha teaches determining whether at least one item desired for purchase by a buyer and at least one item being offered for sale by a seller correspond (see Ojha at least, col.4, lines 49-67, *"...Thus, the present invention provides methods and apparatus for facilitating a transaction between a buyer and one of a plurality of sellers via the Internet. Product information relating to a plurality of products meeting product criteria specified by the buyer is presented via the Internet. One of the plurality of sellers is associated with each of the products. A first bid from the buyer for a first one of the plurality of products is made available via the Internet to a first seller associated with the first product. A first bid response is presented via the Internet to the buyer.* ", and col.8, line 49-col.9, line 18 which disclose the hardware/software that is used to implement the computerized transactions via Internet. Also, see col.9, lines 19-56 and col.14, lines 23-37. Note: The step of, after receiving the buyer's request for a product finding a seller meeting the buyer's product criteria and then getting a offer in response includes the claimed step of determining whether at least one item desired for purchase by a buyer and at least one item being offered for sale by a seller correspond).

Ojha also teaches determining an amount to be added to the price the buyer is willing to pay to match the price for which the item is being offered for sale (see at least Figs. 2,2a, col.9, lines 10-18, *" FIG. 2 is a flowchart 200 illustrating facilitation of a transaction according to a specific embodiment of the invention. FIG. 2a is a flowchart illustrating a multi-step negotiation*

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between a buyer and a seller (see 214 of FIG. 2) according to a more specific embodiment of the invention. FIGS. 3-18 are a series of graphical user interfaces which will be used to illustrate the transaction process of FIGS. 2 and 2a. ", and col.18, lines 6-23, *"Where the seller's response is a counteroffer (254), the counteroffer price appears as a modified ask price in both the merchant's bid list of interface 1100 and the buyer's shopping list of interface 900 as shown in FIGS. 14 and 15, respectively. According to a specific embodiment, entries in the shopping list of interface 900 for which a response has been received from the seller are highlighted in a contrasting color as shown. Where the buyer does not accept the seller's counteroffer, he may adjust his bid by entering a new bid price as shown in FIG. 16. By activating the "Bid" button for that entry in his shopping list the buyer then submits an adjusted bid (258). Note that because the bid has been adjusted, it is treated like a new bid and the entry is no longer highlighted. Alternatively, the buyer may terminate negotiations with the seller at any time (260). In any case, where the buyer and seller have not yet agreed on a price (216), additional rounds of negotiating may take place as described above. "* Note: Ojha explicitly discloses that if buyer does not accept the seller's counter offer in response to his bid he in his response adjusts his earlier bid which inherently implies determining an amount by which the buyer should add to his earlier bid offer in order to bring it to match the price proposed by the seller.).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 95-97 and 99-108 are rejected under 35 U.S.C. 102(e) as being anticipated by Ojha et al. (US Patent 6,598,026), hereinafter referred to Ojha.

Regarding claim 95, Ojha teaches a method, comprising:

receiving, via a computer network, seller offer information, the seller offer information defining a seller and at least one item being offered for sale by the seller and a price at which the at least one item is being offered for sale (see at least col.2, lines 47-62, "*According to the present invention, an electronic commerce solution is provided for facilitating online transactions which allows traditional negotiation between a buyer and a seller to occur. According to a specific embodiment, a web site is provided having individual private graphical user interfaces, e.g., web pages, for buyers and sellers. A buyer gains access to his private interface with a user ID and password. The buyer's interface allows him to search a proprietary database for current product information for a variety of products being offered for sale by a number of sellers. The product information includes, for example, the name of the seller and an ask price and/or a list price for the product as specified by the seller.*" . Note: See Fig.1 and col.8, line 49-col.line 8 which discloses the hardware environment of the invention in which the buyers [represented by the computers 122 and 124], sellers [represented by the computers /servers 108 & computers 114], server [102] communicate via Internet [106] and their websites. Seller's information is received via Internet which includes the sellers offer, that is list price or ask price, see Fig.8.) ; receiving buyer offer information, the buyer offer information defining a buyer and at least one item the buyer desires to purchase a price the buyer is willing to pay for the at least one item the buyer desires to purchase (see at least col.3, lines 6-21, "*For each product saved in the shopping list a bid button is provided, activation of which causes a bid interface to be presented by which the buyer may submit a non-binding bid to the seller of that particular product. Alternatively, the bid interface may be in the shopping list itself. According to a specific embodiment, the bid is made*

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available to a number of different sellers offering the same product. Using the shopping list, the buyer may make a number of bids for the same or different products to a number of different sellers simultaneously. " Submitting of non-binding bids by the buyer corresponds to receiving offer.

See also col.4, lines 49-67 and col.5, lines 40-67 [teaches receiving conditional purchase offers from buyers with an offer price for a desired product]. See also col.15, lines 16-19 which teach receiving buyer details including e-mail address, and col.19, lines 5-11 discloses receiving the buyer's payment and shipping information from a database of previously collected information concerning the buyer.);

receiving credit card account information associated with the buyer (see at least col.21, lines 35-39, "a credit cardaccount may be requested before a party is allowed to negotiate..");

storing the seller offer information (see at least col.11, lines 5-8, " ..Activation of HTML text describing a product entry in the shopping list of interface 700 results in presentation of an interface 800 [fig.8] which provides information about all merchants offering the particular product for sale through the transaction site..." and buyer offer information (see at least, " col.10, lines 8-24, "a buyer can create and simultaneously maintain as many shopping lists as desired.... ". Note: The shopping lists stores the buyer's offer information and col.19, lines 5-11 discloses receiving the buyer's information from a database of previously collected information concerning the buyer);

determining, via a processor, whether the at least one item desired for purchase by the buyer and the at least one item being offered for sale by the seller correspond (see Ojha at least, col.4, lines 49-67, "...Thus, the present invention provides methods and apparatus for facilitating a transaction between a buyer and one of a plurality of sellers via the Internet. Product information relating to a plurality of products meeting product criteria specified by the buyer is presented via the Internet. One of the plurality of sellers is associated with each of the products. A first bid from the buyer for a first one of the plurality of products is made available via the Internet to a first seller associated with the first product. A first bid response is presented via the Internet to the buyer. " , and col.8, line 49-

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col.9, line 18 which disclose the hardware/software that is used to implement the computerized transactions via Internet. Also, see col.9, lines 19-56 and col.14, lines 23-37. Note: The step of, after receiving the buyer's request for a product finding a seller meeting the buyer's product criteria and then getting a offer in response includes the claimed step of determining whether at least one item desired for purchase by a buyer and at least one item being offered for sale by a seller correspond.);

determining a first amount to be added to the price the buyer is willing to pay to match the price at which the at least one item is being offered for sale if the buyer offer information and seller offer information do not initially correspond (see at least Figs. 2,2a, col.9, lines 10-18, " *FIG. 2 is a flowchart 200 illustrating facilitation of a transaction according to a specific embodiment of the invention. FIG. 2a is a flowchart illustrating a multi-step negotiation between a buyer and a seller (see 214 of FIG. 2) according to a more specific embodiment of the invention. FIGS. 3-18 are a series of graphical user interfaces which will be used to illustrate the transaction process of FIGS. 2 and 2a.* ", and col.18, lines 6-23, "*Where the seller's response is a counteroffer (254), the counteroffer price appears as a modified ask price in both the merchant's bid list of interface 1100 and the buyer's shopping list of interface 900 as shown in FIGS. 14 and 15, respectively. According to a specific embodiment, entries in the shopping list of interface 900 for which a response has been received from the seller are highlighted in a contrasting color as shown. Where the buyer does not accept the seller's counteroffer, he may adjust his bid by entering a new bid price as shown in FIG. 16. By activating the "Bid" button for that entry in his shopping list the buyer then submits an adjusted bid (258). Note that because the bid has been adjusted, it is treated like a new bid and the entry is no longer highlighted. Alternatively, the buyer may terminate negotiations with the seller at any time (260). In any ease, where the buyer and seller have not yet agreed on a price (216), additional rounds of negotiating may take place as described above.* ".

Note: Ojha explicitly discloses that if buyer does not accept the seller's counter offer in response

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to his bid he in his response adjusts his earlier bid which inherently implies determining an amount by which the buyer should add to his earlier bid offer in order to bring it to match the price proposed by the seller.);

charging the credit card account associated with the buyer the price at which the at least one item is being offered for sale (See at least col.21, lines 30-40 which discloses consummating the deal and using a payment identifier, such as credit card to do so); and

crediting the seller an amount based on the price at which the at least one item is being offered for sale (see at least col.6, lines 5-10 and 21, lines 36-40 which teaches paying/crediting the seller using the payment identifier, which could be a credit card or a billing account)..

Regarding claim 96, Ojha discloses that the method of claim 95, wherein said determining whether the at least one item desired for purchase by the buyer and the at least one item being offered for sale by the seller correspond comprises:

comparing a desired condition set by the buyer and a condition of the at least one item offered for sale (see at least col.6, lines 5-10 which discloses comparing the conditional purchase offer price, which is the desired condition set by the buyer and is compared with the seller's offer if it matches with the conditional offer price).

Regarding claim 97, Ojha discloses that the method of claim 95, wherein the first amount to be added comprises a conditional subsidy offered to the buyer (see at least col.19 lines 12-53 which discloses buyers getting incentives if they influence other prospective buyers to use the transaction web site on server 102 and these incentives could be in the form of dollars or discounts which could be used by the buyer in future transactions. Also, see col.3, lines 44-57,

".....In addition, a seller could give preferential treatment, e.g. discounts, to buyers.....".. Note: sellers providing a discount corresponds to subtracting the subsidy from a seller's price).

Regarding claim 99, Ojha discloses that in the method of claim 95, wherein receiving the seller offer information obligates the seller to deliver the at least one item offered for sale if the at least one item desired for purchase by the buyer and the at least one item being offered for sale by the seller correspond (see at least col.6, lines 5-10 which discloses that if the seller accepts the conditional purchase offer from the buyer then the transaction is completed and payment is made to the seller, which implies that the seller would be obligated to deliver at least one item offered for sale to the buyer).

Regarding claim 100, Ojha discloses that the method of claim 99, further comprising:
determining that the seller has failed to deliver the at least one item being offered for sale; and charging the seller a penalty (see at least col.21, lines 30-40, " However, it will be understood that negotiations may be made partially or fully binding without departing from the scope of the invention. That is, a payment identifier such as, for example, a credit card or billing account may be requested before a party is allowed to negotiate. If the party attempts to terminate negotiations prematurely, some sort of penalty may be assessed to the identified account. ". Note: If either the seller or buyer do not abide by their offers they are subject to a penalty and are obligated to complete a transaction.).

Regarding claims 101 and 102, Ojha teaches that the method of claim 95, wherein receiving the buyer offer information obligates the buyer to pay for the at least one item the buyer desires to purchase if the at least one item desired for purchase by the buyer and the at

least one item being offered for sale by the seller correspond by paying the at least one item the buyer desires to purchase penalty and wherein the buyer is charged a penalty if the buyer fails to pay for the at least one item the buyer desires to purchase (see at least col.21, lines 30-40, "*..... However, it will be understood that negotiations may be made partially or fully binding without departing from the scope of the invention. That is, a payment identifier such as, for example, a credit card or billing account may be requested before a party is allowed to negotiate. If the party attempts to terminate negotiations prematurely, some sort of penalty may be assessed to the identified account. "*

Note: If either the seller or buyer do not abide by their offers they are subject to a penalty and are obligated to complete a transaction which includes that buyer must make the payment.).

Regarding claim 103, Ojha discloses that the method of claim 95, further comprising:
determining a subsidy which is associated with a benefit from a subsidy provider to be applied to the transaction, wherein said determining a first amount to be added comprises arranging for the seller to provide the item to the buyer in accordance with the subsidy (see at least col.19 lines 12-53 which discloses buyers getting incentives if they influence other prospective buyers to use the transaction web site on server 102 and these incentives could be in the form of dollars or discounts which could be used by the buyer in future transactions.
Note: The subsidy provider is the owner of the web site of the server 102 and that subsidy is provided to the buyer when a merchant [seller] accepts a bid from the buyer to purchase a desired product.).

Regarding claims 104 and 105, Ojha discloses that the method of claim 95, wherein said receiving seller offer information comprises:

receiving the seller offer information from the seller and receiving the buyer offer information from the buyer via at least one of: (i) a Web site, (ii) the Internet, (iii) a seller computer, (iv) a personal digital assistant, (v) a kiosk, (vi) an electronic mail message, (vii) a telephone, (viii) an interactive voice response unit, and (ix) an operator (see at least FIG.1 and col.8, line 49-col.9, line 9).

Regarding claims 106-108, their limitations are closely parallel to the limitations of claims 95-96, 99-102 and 104-105.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 98 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ojha in view of Kelly et al. (US Patent 6,012,925), herein after referred to Kelly.

Regarding claim 98, Ojha discloses the method of claim 95 as analyzed above but does not disclose that the first amount to be added comprises a conditional subsidy offered to the seller. However, Kelly in the business of selling cattle, teaches providing conditional subsidy to the offer in order to complete a sale transaction (see at least col.3, lines 9-15, " ... *The seller of the product or commodity is referred to as the "client" or "customer" or other terms, depending upon the product or commodity. **This method guarantees that the seller will obtain a remuneration subsidy or "settlement" for the product or commodity at the time of sale, should the sale price be below the cost to produce the product or commodity.*** ". Note: The provided subsidy is conditional that is if the sale price or to consummate a transaction the selling price falls below than the cost of the product.). In view of Kelly, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ojha to incorporate Kelly's teaching of providing a conditional subsidy to the seller to complete the transaction based upon the buyer's offer because, as explicitly disclosed in Kelly, it will help the seller to mitigate or reduce the losses in having to sell its goods to the buyer.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,332,129 to Walker et al. discloses an electronic buyer driven commerce system method and system wherein the buyers' offers are subsidized on determining if their offers do not match the seller's offers (see at least abstract).

(ii) US Patent 6,243,691 B1 to Fisher et al. discloses an electronic auction method and system, wherein it allows the auction manger to determine an amount to be added to the price

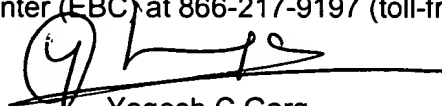
the buyer is willing to pay up to a limited amount (see at least col.8, lines 56-66) thereby allowing the buyer to get the lowest possible price without exceeding a predetermined limit.

(iii) US Patent 6,598,027 B1 to Breen, Jr. et al. discloses an electronic commercial transaction method and system for goods, wherein it allows potential buyers to automatically increase his/her bids by an incremental amount up to a predetermined maximum amount in response to higher bids from other bidders to place a winning bid (see at least col.21, lines 30-44).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
April 8, 2005